

REMARKS

After entry of the amendment herein, claims 1-7, 26-29, 31 and 32 are pending. Claims 1, 26 and 29 were amended herein and claims 8, 13-21, 23 and 25 were canceled herein. Support for the amendments to claims 1 and 29 can be found at least in the original claims. Support for the amendments to claim 26 can be found at least at page 39 of the specification. No new matter is added by these amendments.

Rejections Under Section 112, Second Paragraph

Claims 8, 13-21, 23 and 25 were canceled herein.

Claims 1-8, 13-21, 23, 25-29, 31 and 32 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter for various reasons. Claim 1 was rejected as containing improper Markush language. Applicants have amended claim 1 to comply with proper Markush language and request that the rejection of claim 1 be withdrawn.

Claims 1, 26 and 29 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter due to the listing of the optional substituents in the independent claims. Applicants respectfully submit that each of the listed substituents is clearly defined in the specification at pages 7-22 as proper substituents having open valencies as a point of attachment. Applicants respectfully submit that substituents need an open valency and not a radical as a point of attachment. Applicants respectfully submit that claims 1, 26 and 29 are definite in light of the specification and request that the rejection be withdrawn.

Claims 26 and 29 were rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps. Applicants have amended claims 26 and 29 to clarify the claimed invention. Claim 26 has been amended to indicate that the C7 or C8 hydroxyl group is deprotected to form compounds Ia or Ib. Applicants respectfully submit that claim 29 is not incomplete. Y-R"-Y' is not replaced with X-R"-X'. In some embodiments, the X and X' come from the Y-R"-Y' reagent. In other embodiments the X and X' come from the unprotected hydroxyls at C7 or C8. Applicants respectfully request that the rejection of claims 26 and 29 under § 112, second paragraph, be withdrawn in light of the above.

The remaining claims are dependent on one of claims 1, 26 and 29 and therefore are patentable for at least the above reasons. Applicants request that the § 112, second paragraph, be withdrawn.

Rejections Under Section 112, First Paragraph

Claims 1-8, 13-21, 23, 25-29, 31 and 32 are rejected under 35 U.S.C. § 112, first paragraph, as not enabled for solvates. Claims 8, 13-21, 23 and 25 were canceled herein. Without acquiescing to the propriety of the rejection, Applicants have amended claims 1 and 29 to delete the term solvates in order to advance prosecution. Applicants request that the rejection be withdrawn.


Rejections Under Section 103

Claims 8, 9, 13-16 and 18-21 were rejected under § 103(a) as unpatentable over Smellie et al. (Biochemistry (2003), 42(27), 8232-39). Without acquiescing to the propriety of the rejections, Applicants have cancelled claims 8, 9, 13-16 and 18-21 in the interests of advancing prosecution. Applicants request that the rejection be withdrawn.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance. Should the examiner feel that any issues remain or wish to discuss anything further, the examiner is invited to contact the undersigned at the number below. No other fees are believed due in connection with the above response. Should any fee, in fact, be due, please charge Deposit Account No. 50-0842.

Respectfully submitted,


Charlene L. Yager
Reg. No. 48,887

Michael Best & Friedrich LLP
One South Pinckney Street
P. O. Box 1806
Madison, WI 53701-1806
608.257.3501
065435-9081 US00